

O-390-03

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2274082  
BY EASYROOMS LTD  
FOR THE TRADE MARK:**

**Easyrooms**

**AND THE OPPOSITION THERETO UNDER NO 80461  
BY EASYGROUP IP LICENSING LIMITED**

**Trade Marks Act 1994  
in the matter of application no 2274082  
by Easyrooms Ltd  
for the trade mark:  
Easyrooms  
and the opposition thereto under no 80461  
by easyGroup IP Licensing Limited**

1) On 22 November 2002 I issued a provisional decision in relation to this opposition. The decision was provisional as the final outcome depended upon the registration of trade mark applications. One of those applications has now been registered; United Kingdom trade mark registration no 2246286 of the trade marks (a series of two):

**EASYHOTEL**

**easyHotel.**

2) In the original decision I stated the following:

“105) Taking all the above factors into account I find that there is a likelihood of confusion with the trade marks easyHotel/EASYHOTEL in respect of all the services of the application.

106) However, I cannot leave the matter there. The easyHotel/EASYHOTEL trade marks are applications. They cannot be fatal to Easyrooms’ application unless they are registered. The matter will also hinge upon for what goods and services the trade marks are eventually registered. It could be, if they are registered, that they are registered for goods and/or services that are not similar to those encompassed by the **Easyroom** trade mark. Consequently, I still need to consider the position in relation to the other trade marks and grounds of opposition upon which easyGroup rely.”

3) The application is for the following services:

*travel insurance;*

*telecommunications services, Internet communications services;*

*organising of transport and of travel by air, land and sea, organising of holiday travel services;*

*booking of temporary accommodation.*

The above services are in classes 36, 38, 39 and 42 respectively of the International Classification of Goods and Services.

The opponent's registration includes all these classes. These are the services covered by the registration in classes 36, 38, 39 and 42 respectively:

*financial and insurance services;*

*telecommunication services; provision of user access to the Internet; provision of access to the Internet for recreational purposes; providing access to information on-line from a computer database or provided with facilities from the Internet;*

*transportation of goods, passengers and travellers by air; airport check-in services; arranging of transportation of goods, passengers and travellers by land; bus transport services, car transport service, coach services; airline services; baggage handling services; cargo handling and freight services; operating and providing facilities for tours; cruises, excursions and vacations; chartering of aircraft; rental and hire of vehicles, boats and aircraft; aircraft fuelling services, aircraft parking services; ambulance services; travel agency and tourist office services; advisory and information services relating to the aforesaid services; information services relating to transportation services, including information services provided on-line from a computer database or the Internet; travel reservation and travel booking services provided by means of the World Wide Web;*

*temporary accommodation; catering, hotel, restaurant, cafe and bar services; bistro services; snack bar services; public house services; wine bar services; providing hotel accommodation; reservation services for hotel accommodation; computerised hotel reservation services; room hire services; health clinic services; health farm services; chiropody; cosmetic treatment; massage services; provision of solarium services; crèche facilities; child care services; hairdressing, grooming and beauty salon services; reservation services for all the aforesaid services; provision of exhibition facilities and amenities; provision of facilities and amenities all for conferences, seminars and banquets; reservation services for all the aforesaid services; meteorological information services; security services; airport security services; airline passenger security screening services; design of computer software; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; posting, creating and maintaining websites for others; leasing access time to a computer database; provision of access to computers; providing and rental of exhibition areas; providing and rental of exhibition facilities; Internet cafe services; rental of clothing.*

I do not consider that there is any doubt that the services of the registration encompass the services of the application. Consequently, the respective services are identical.

4) It follows that the provisional finding that there is a likelihood of confusion is confirmed.

5) *Rizla Ltd's Application* [1993] RPC 365 confirms that in the matter of costs the registrar has a wide discretion. In *BUD and Budweiser Budbräu Trade Marks* [2002] RPC 38, Mr Simon Thorley QC, sitting as a deputy judge of the High Court,

accepted that off the scale costs could be awarded where a side had behaved unreasonably or put in a large amount of evidence that is of little or no relevance. In that case Mr Thorley was considering the actions of the losing side. However, I consider that such a consideration can equally apply to the winning side. It is a matter of whether the other side was put to effort and expense which, taking into account the nature of the evidence, served no purpose.

6) In this case the opponent relied upon an enormous number of earlier rights, the vast majority of which had no bearing upon the case. The use of so many earlier rights might be seen by some to be oppressive. The evidence of the opponent was also ill focused. For all the earlier rights and evidence, the issue came down to two trade mark applications and section 5(2)(b) of the Act. I consider that the applicant will have been put to a great deal of unnecessary trouble and expense. Consequently, although the opponent has been successful I do not intend to award him any costs.

### **Conclusion**

**7) The application is to be refused in its entirety. There is no award of costs.**

**Dated this 15<sup>th</sup> day of December 2003**

**David Landau  
For the Registrar  
the Comptroller-General**